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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.,

Case No. CV 10-03561 WHA

Plaintiff,

**ORACLE'S REPLY IN SUPPORT OF  
ITS MOTION IN LIMINE #1 REGARD-  
ING OPENJDK**

v.

GOOGLE INC.,

Date: April 14, 2016 at 8:00 am  
Dept.: Courtroom 8, 19th Floor  
Judge: Honorable William H. Alsup

Defendant.

1        After steadfastly claiming for years that it could never adopt OpenJDK, Google launched  
 2 an about-face strategy after the close of fact discovery in the remanded case. The approach is  
 3 designed to confuse the jury into believing that Google had consent for Android because there  
 4 was an open-source alternative, even though Google repeatedly rejected it. Google also  
 5 misrepresents the nature and meaning of the license terms.<sup>1</sup> Oracle filed its Motion to put a stop  
 6 to this misleading and prejudicial strategy. In response, Google offers *other* justifications for  
 7 referencing OpenJDK, two of which (publication and consent) are more slippery impropriety than  
 8 ever, and one of which (fragmentation) was not even the subject of the Motion. Google should be  
 9 precluded from offering evidence or argument (1) that Google could have used OpenJDK for  
 10 Android versions through Marshmallow (the only versions at issue in this trial), ECF Nos. 1488,  
 11 1506, and that Google is supposedly using OpenJDK in future Android versions, (2) misrepre-  
 12 senting the terms of the GPLv2-CE license, (3) that the existence of OpenJDK justifies Google's  
 13 use even though it did not comply with that license, and (4) that OpenJDK supports fair use for  
 14 any reason other than "fragmentation," the only reason Google actually disclosed in discovery.

15 **I. REFUTED COUNTERFACTUALS MUST BE EXCLUDED.**

16        *Joiner* and *Kumho Tire* prevent a party from using an expert as a mouthpiece for theories  
 17 that cannot be sustained by the evidence in the case. *Gen. Elec. Co. v. Joiner*, 522 U.S. 136, 152  
 18 (1997) (requiring opinion to "fit" the facts); *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 154  
 19 (1999) (requiring reliability as to "the particular matter"). Counterfactuals that are refuted by the  
 20 record evidence are demonstrably improper. *Concord Boats Corp. v. Brunswick Corp.*, 207 F.3d  
 21 1039, 1057 (8th Cir. 2000). The idea that Google could have used OpenJDK for any version of  
 22 Android through Marshmallow is an improper counterfactual. Google affirmatively rejected it.  
 23 See, e.g., TX154; ECF 1608-2 (Swetland Depo.) 139:3-8; ECF 1563-19 (Bloch Depo.) 206:8-21.

24        Google cites no evidence to support the notion that it would have adopted OpenJDK at  
 25 any time before its announcement on December 24, 2015. Instead, Google tries to undermine

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26       <sup>1</sup> Relevant portions of OpenJDK are released under the GNU Public License Version 2 with  
 27 Classpath Exception. Mot. 2. Google attempts to confuse by referring to a "Classpath License." There is no such thing. There are two added paragraphs at the end of GPLv2 that create an exception for distribution of binary executable class libraries; that's why it's called the Classpath *Ex-ception*. This exception is inapplicable to Google's distribution of Android *source code*.

1 some of the cited evidence by misrepresenting its contents or proffering strained interpretations.  
 2 For example, Google claims that a November 13, 2006 email demonstrating that Google under-  
 3 stood exactly which license was at issue before it made its decision to reject OpenJDK relates on-  
 4 ly to Java ME. Opp. 7-8. But the face of the document refers to “GPL2+Classpath exception for  
 5 the SE libraries.” ECF No. 1566-5 (Ex. 13). Google also criticizes Oracle for relying on a sepa-  
 6 rate email (Opp. 9 (discussing ECF No. 1566-5 (Ex. 17))), but *the author of the email testified that*  
 7 *the suggestion of moving to OpenJDK was rejected because of licensing concerns*:

8 Q. And why was -- why did you regard [using OpenJDK] a verboten topic?

9 A. Because I'd heard it discussed before and quickly the discussions would always end  
 10 with, you know, we can't do that. *Our partners can't use GPL code* other than the Linux  
 kernel itself. (ECF 1563-19 (Ex. 18, Bloch Depo.) 208:8-21 (emphasis added)).

11 Google points to the recent deposition testimony of Mr. Ghouloum—a current Google em-  
 12 ployee and 30(b)(6) deponent—to attempt to show that OpenJDK is an acceptable alternative.  
 13 Opp. 4. Google omits the fact that Mr. Ghouloum testified that he was *uncertain* whether OEMs  
 14 would accept OpenJDK even today. ECF 1608-5 (Ghouloum Depo.) 58:17-21. And regardless,  
 15 Mr. Ghouloum's beliefs about what OEMs would accept *today* is not relevant to what OEMs  
 16 would have accepted in the markedly different commercial landscape of 2007, *see* Mot. 10, and  
 17 cannot explain away the contemporaneous evidence of Google rejecting OpenJDK during the rel-  
 18 evant time frame. Google's reliance on *other* parts of Android code as subject to GPL licenses  
 19 (Opp. 4) is also of no consequence. Google's argument that Linux in Android is copyleft ignores  
 20 its own public statements about GPL'd code (including Linux specifically) in Android, and also  
 21 ignores that the 37 Java APIs are in *core libraries* and are critical to development on Android.

22 Google also tries to explain away evidence of its rejection of OpenJDK by claiming it was  
 23 for issues other than licensing concerns. Opp. 9. But the record shows that Google's lawyers  
 24 were carefully vetting OpenJDK at the time, as demonstrated by privilege log entries where ad-  
 25 vice was sought about this very issue.<sup>2</sup> For example, the log reflects an email exchange of Dec. 7,  
 26

27 <sup>2</sup> ECF No. 1385-1, Entries 858-860, 871, 877-878, 947, 1097-1100, 3510, 3547-3548, 3560-3561,  
 28 4376-4382, 4715, 4717-4719, 4721, 5850-5852, 10025-10029, 10034, 10044, 10076-10078,  
 12216, 13489-13494, 13500-13505, 13508-13510, 13552, 13563-13575, 13585-13590, 14186-  
 14188, 14208, 14215-14218, 15578, 15814-15818, 21089, 29769, 29773-29774, 29789.

1 2009, seeking “advice of counsel re use of OpenJDK licensing in Android and mixing of GPL  
 2 and Apache licensed code.” Entry 4715. The Android people understood full well that they  
 3 *could not use* OpenJDK. TX415 (“the lawyer-advised consensus is that there is potential for  
 4 trouble”). Having withheld these privileged documents supporting Oracle’s position, Google  
 5 cannot argue the contrary. *Chevron Corp. v. Penzoil Co.*, 974 F.2d 1156, 1162 (9th Cir. 1992).

6 There is no evidence that Google could have used OpenJDK in any version of Android  
 7 through Marshmallow. Google’s production of an uninformed 30(b)(6) witness, a single email  
 8 dated November 2015 announcing a change after rejecting OpenJDK in Android for 8 years, and  
 9 work-in-progress source code does not amount to evidence that Google could have used Open-  
 10 JDK in all 40 major and minor releases of Android since 2007. Google’s experts and attorneys  
 11 should be precluded from presenting speculation to the contrary.

## 12 II. GOOGLE’S NEW FAIR USE ARGUMENTS SHOULD BE EXCLUDED.

13 Google argues for *new* grounds of relevance of OpenJDK to fair use that were not  
 14 previously disclosed: publication and consent. Opp. 4-5. Oracle propounded an interrogatory  
 15 asking for a complete explanation of Google’s theory of fair use. ECF 1566-5 (Ex. 21), No. 40.  
 16 In its response, Google referred to OpenJDK for a sole proposition: that Google’s infringement  
 17 did not harm the market under factor four because OpenJDK “enabled the fragmentation of the  
 18 Java SE.” *Id.* As noted, Oracle does not seek to preclude this theory. But Google now tries to  
 19 add two theories never before disclosed: that publication in OpenJDK is relevant to factor two,  
 20 and that OpenJDK somehow shows Oracle’s “consent” to Google’s infringement. These  
 21 attempts to expand Google’s fair use defense beyond its disclosures are improper. *Calhoun v.*  
 22 *United States*, 591 F.2d 1243, 1246 (9th Cir. 1978); ECF No. 110 at 7:5-20 (transcript); *Doe v.*  
 23 *Reddy*, No. C 02-05570 WHA, 2004 U.S. Dist. LEXIS 30792, \*14-15 (N.D. Cal. Mar. 24, 2004).

24 **Factor Two.** Google’s new argument that OpenJDK must be considered as part of the  
 25 “nature of the work” fails to advance its argument. The Java API Specification was widely  
 26 published and disseminated *in books and online* long before OpenJDK. See <https://web.archive.org/web/20061106235419/http://java.sun.com/j2se/1.5.0/docs/api/>. The fact that an unpublished  
 27 work is entitled to a much higher degree of protection than a published one, *Harper & Row*  
 28

1      *Publ'rs, Inc. v. Nation Enters.*, 471 U.S. 539 (1985), tells us nothing about the necessity of  
 2 mentioning OpenJDK when the work was already long since widely disseminated. Moreover,  
 3 *Harper & Row* explains that “[i]t is fundamentally at odds with the scheme of copyright to accord  
 4 lesser rights in those works that are of greatest importance to the public.” *Id.* at 559. To accord a  
 5 *published* work less protection merely because it is published would be at odds with this mandate.

6            **“Consent.”** Oracle noted its concern that Google would ignore the license restrictions and  
 7 tell the jury it had the right to use the declaring code and SSO because of OpenJDK, just as  
 8 Google told the Court at the tutorial. Mot. 7. Rather than assure the Court that it does not intend  
 9 to mislead, Google doubles down and makes clear that is *exactly* what it plans to do. Taking a  
 10 truly remarkable (and previously undisclosed) position, Google asserts that “[t]he jury is entitled  
 11 to consider evidence that Sun voluntarily *did* consent to use of the declarations/SSO,” and that  
 12 Sun’s release of OpenJDK “is compelling evidence that it was reasonable for Google to use the  
 13 declarations/SSO.” Opp. 4-5. However, Google conceded that it is not pursuing an express  
 14 license defense, and the Court rejected its implied license defense. ECF Nos. 1203, 1456.  
 15 Assertions of “consent” because Sun offered a *license* for parties who wished to copy Sun’s code  
 16 are nothing more than an obvious attempt to confuse and mislead the jury.

17            Sun’s decision to release a *licensed* version of the 37 Java API Packages in order to  
 18 promote a dual licensing model does not give Google—or anyone else—carte blanche to ignore  
 19 the restrictions of that license and violate Sun’s copyrights. As the Federal Circuit recognizes,  
 20 open-source “licenses have been designed to provide creators of copyrighted materials a means *to*  
 21 *protect and control their copyrights.*” *Jacobsen v. Katzer*, 535 F.3d 1373, 1378 (Fed. Cir. 2008)  
 22 (emphasis added). Allowing Google to argue that Sun *consented* to illegal copying because Sun  
 23 licensed software to others would render those licenses (and the copyright) meaningless.

24            **Factor Four.** Google’s OpenJDK argument on factor four should be limited to claiming  
 25 that Sun fragmented itself, as that is all that it disclosed in its interrogatory response. *Supra* 3.  
 26 Moreover, no Google economist offered an opinion for the fourth factor of fair use. As Google’s  
 27 own open-source expert acknowledged, dual-licensing is common. ECF No. 1566-2 ¶¶ 75-77.  
 28 And it is undisputed that Sun/Oracle continued to earn significant license revenue from Java SE

1 after releasing OpenJDK. Thus, Google's mere supposition that OpenJDK harmed potential  
 2 markets is of no moment. *See Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1181 (9th Cir.  
 3 2012) (affirming summary judgment ruling that factor four weighed against fair use, noting that  
 4 defendant “[did] not offer any evidence of the relevant market or the lack of market harm from its  
 5 publication other than broad, unsubstantiated statements in its brief”).

### 6 **III. HALL'S CONTRACT INTERPRETATIONS SHOULD BE EXCLUDED.**

7 In his Opening Report describing Android's use of OpenJDK, Mr. Hall ignores all provi-  
 8 sions of the GPLv2-CE license except the Classpath Exception, and concludes that Android's use  
 9 of OpenJDK is permissible. ECF No. 1566-2. The only evaluation that Hall performed relates to  
 10 the legal propriety of Google's December 2015 publication of beta code purporting to implement  
 11 OpenJDK, yet he casts that evaluation backwards in time to 2007. *Id.* ¶¶ 2, 27. Google failed to  
 12 address Oracle's arguments that (1) Hall's evaluations and opinions are improper legal testimony,  
 13 (2) Hall's failure to investigate the true facts regarding Google's decision not to use OpenJDK in  
 14 2007 was improper under *Monotype Corp. PLC v. Int'l Typeface Corp.*, 43 F.3d 443, 449 (9th  
 15 Cir. 1994), and (3) Hall lacks specialized knowledge to discuss open-source due diligence as of  
 16 the relevant 2007 time period. Hall should be precluded from testifying about his interpretation  
 17 of the GPLv2-CE and how it applies to Android, either now or in 2007.

18 Having failed to rebut Oracle's arguments, Google shifts ground and offers Hall as a  
 19 “background” witness. Opp. 9-10. General background on open-source licensing is of limited  
 20 probative value and a prejudicial waste of time. Finally, Google concedes that Hall actually “of-  
 21 fers a *technical* opinion regarding the linking done by OEMs and developers.” Opp. 10. But Hall  
 22 is not a technical *expert* and has no specialized knowledge relating to Java. *See* Mot. 12.

### 23 **CONCLUSION**

24 For the foregoing reasons, the Court should grant Oracle's motion in limine and also fur-  
 25 ther preclude Google from presenting evidence, testimony, or arguments at trial that were not  
 26 properly disclosed by Google during discovery.

27  
 28

1 Dated: April 13, 2016

Respectfully submitted,

2 Orrick, Herrington & Sutcliffe LLP

3 By: /s/ Annette L. Hurst

Annette L. Hurst

4 Counsel for ORACLE AMERICA, INC.

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